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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,618	10/17/2001	Jeffrey D. Musselwhite	DLY-014;CIP	8760

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EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,618

Applicant(s)

MUSSELWHITE ET AL.

Examiner

Zakiya N. Walker

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 26-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57-67 is/are allowed.
- 6) ☒ Claim(s) 6-8, 10-13, 17-25, 36-47 and 50-52 is/are rejected.
- 7) ☒ Claim(s) 9, 14-16, 48, 49 and 53-56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. The preliminary amendment filed 12/13/01 (paper #4) has been entered in part. With regards to the specification, applicant must submit an unmarked version (as well as a marked version) of a full paragraph to be entered or substituted for an existing paragraph. The claims have been entered in their entirety.

### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a method of cementing a tubular string in a well, classified in class 166, subclass 285.
  - II. Claims 6-25 and 36-67, drawn to a method and apparatus (float shoe) used in installing/lowering a tubular string in a well, classified in class 166, subclass 386.
  - III. Claims 26-28, drawn to a method of making float equipment, classified in class 166, subclass 378.
  - IV. Claims 29-35, drawn to a method of completing a well by providing a pressure responsive receptacle within a tubular string, classified in class 166, subclass 376.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the float equipment can be made by another and materially different process.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operations and different functions that can be used with a variety of different tools.

5. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I is restricted to cementing a tubular in a well, where the float equipment of invention II can be used for more than one process and has separate utility such as washing a well. See MPEP § 806.05(d).

6. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as washing a well. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for any of the Groups is not required for any other Group, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. During a telephone conversation with William Johnson on 8/12/02 a provisional election was made without traverse to prosecute the invention of group II, claims 6-25 and 36-67. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5 and 26-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

✓ 12. Claims 43-46 are objected to because of the following informalities: claim 43, line 5 the term "movable" should be replaced with --moveable--. Consistent terminology must be used throughout the claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 8 and 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- ✓ 15. Claim 8 recites the limitation "said valve seats" in line 3. There is insufficient antecedent basis for this limitation in the claim. It appears the claim should depend from claim 7.

- ✓ 16. Claim 50 recites the limitation "said first selected fluid pressure" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 51 recites, "a second selected fluid pressure" in lines 2-3, which would suggest that a first one exists. The rejections of both claims 50 and 51 may be overcome by inserting the term -- selected-- after the term "first" in line 3 of the parent claim 49.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 6-8, 10-12, and 17-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman'241 (cited by applicant).

Freeman'241 discloses a differential fill valve assembly that includes float collar/shoe equipment 20 comprising an outer tubular member 22 an inner tubular member (moveable member 130), and one or more valves 66, 186. With respect to claims 7, 8, 10-12, 17, and 18, the reference further teaches one or more valve seats 58, 184, a drop member seat 136, a plurality of flapper valves 66, 186, a drop member (ball), and one or more jets 174, 110, 112. With respect to claims 19-25, the method teaches insulating one or more valves, selectively uncovering the valves, dropping a member in the tubular, selectively closing/blocking one or more passageways (jets), the jets include up jet 174 and down jet (110, 112), and selectively exposing one or more check valves 170 to fluid pressure.

19. Claims 19-25, 36-41, 43, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Blizzard et al.

Blizzard et al. discloses a method and apparatus that includes well equipment having an outer tubular member 12, 12a, a moveable member 32, 32a, at least one down jet/second jet 89, at least one up jet/first jet 60a, one or more valves 26, 26a with seats, and a drop member (shift tool at 80). With respect to claims 19-25, the method teaches insulating one or more valves, selectively uncovering the valves, dropping a member in the tubular, selectively closing/blocking one or more passageways (jets), and selectively exposing one or more check valves 26, 26a to fluid pressure.

20. Claims 36, 37, 40, 41, 43, 45, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (cited by applicant) or Tailby.

Davis discloses a downhole tool that includes well equipment having an outer tubular 14, one or more moveable members 38, at least one down jet/second jet 34, and at least one up jet/first jet 26.

Tailby discloses a downhole wash tool that includes well equipment having an outer tubular 10, one or more moveable members 12, at least one down jet/second jet 22B, and at least one up jet/first jet 26A.

21. Claims 13, 17, 18, 22-25, 36, and 40-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al.

Ross et al. discloses an apparatus and method that includes float collar/shoe equipment 50 with a tubular string (B, S, 80), a moveable member 614 (with respect to claims 17 and 18), one or more jets (510, 505, 454), a drop member (ball A), and one or more valves 512. With respect to claims 22-25, the method teaches pumping into the tubular string, selectively blocking one or more down jets (510, 505), selectively blocking one or more up jets 454, selectively exposing one or more check valves 512, releasing a drop element (ball A) to slide moveable member 614 (which activates 520 to block down jets). With respect to claim 36, the reference teaches well equipment having an outer tubular member 19, 50, at least one down jet 505, 510, and a moveable member 520. With respect to claims 40-46, the reference teaches one or more moveable members 520, 456, up/first jets 454, down/second jets 505, 510, and one or



more float valves 50. With respect to claim 13, the reference teaches outer tubular member 452, at least one up jet 454, and moveable member 456.

### ***Double Patenting***

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

23. Claim 47 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,401,824. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the instant invention broadly recites the outer tubular affixed to the string, where the claim of US'824 includes a further limitation, which is clearly taught by both. Further, the claim of the instant invention substitutes the terms "auto-fill mode" and "back pressure mode" for the analogous terms "two-way mode" and "one-way mode" of the US'824 claim. Both sets of terms are used to describe the same functions and are considered equivalent. Therefore, it would have been considered

obvious to have provided a claim which further limited the outer tubular and substituted equivalent terms in US'824 in order to provide alternate claim language.

***Allowable Subject Matter***

24. Claims 57-67 are allowed.
25. Claims 9, 14-16, 48, 49, and 53-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
26. Claims 50-52 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Monday-Thursday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 746-3826 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

  
Zakiya N. Walker  
Examiner  
Art Unit 3672

ZW  
August 13, 2002